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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* LAURENCE B. BOUCHER, CLIVE M. PHILBRICK,  
DARYL D. STARR, STEPHEN E.J. BLIGHTMAN, PETER K. CRAFT,  
and DAVID A. HIGGEN

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Appeal 2008-0376<sup>1</sup>  
Application 10/724,588  
Technology Center 2100

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Decided: June 16, 2008

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Before LANCE LEONARD BARRY, JEAN R. HOMERE, and  
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1 through 8, 10 through 14, 16 through 27, 29 through 40, and 42. Claim 9 never existed in the Application. Claim 15 has been canceled. Claims 28 and 41 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to

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<sup>1</sup> Filed Nov. 28, 2003. The real party in interest is Alacritech, Inc.

include the limitations of the base claim and any intervening claims. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

#### The Invention

As depicted in Figure 1, Appellants invented a system for enabling a local host (20) to communicate with a remote host (22) via a network (25). (Spec. 10.) Particularly, the local host (20) includes a communication processing device (CPD) (30) and a central processing unit (CPU) (28), wherein the CPU provides to the CPD a media access control (MAC) address, an internet protocol (IP) address, and a transmission control protocol (TCP) port. The CPD processes incoming messages and controls TCP connections created by the CPU between the two hosts. (Spec. 16.)

Independent claim 1 further illustrates the invention. It reads as follows:

1. A system for communication by a local host that is connectable by a network to a remote host, the system comprising:

a communication processing device (CPD) that is integrated into the local host to connect the network and the local host, said CPD including hardware configured to analyze Internet Protocol (IP) and Transmission Control Protocol (TCP) headers of network packets, and

a central processing unit (CPU) running protocol processing instructions in the local host to create a TCP connection between the local host and the remote host, said CPU providing to said CPD a media-access control (MAC) address, an IP address and a TCP port that correspond to said connection, wherein said CPD and said CPU are configured such that a message transferred between the network and the local host is generally processed by said CPD instead of said CPU when said CPD controls said connection and said message corresponds to said connection.

The Examiner relies upon the following prior art:

Bennett US 6,345,302 B1 Feb. 05, 2002

The Examiner rejects the claims on appeal as follows:

Claims 1 through 8, 10 through 14, 16 through 27, 29 through 40, and 42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bennett.

#### FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

##### *Bennett*

1. As shown in Figure 1, Bennett discloses a system for connecting a computer (1005) at a local node (1000) with another computer at a remote node (276) via a network (106). (Col. 3, ll. 22-38.)

2. As depicted in Figure 2B, the local node (1000) has at its transport layer (900) a TCP process (91) executed by a CPU (10). It also includes a TCP logic which is processed on a network interface card (NIC) (2000). (Col. 4, ll. 51- 62.)

3. The NIC (2000), upon receiving a TCP/IP packet from the network (106), examines the packet to generate a checksum acknowledging that the data is valid. (Col. 12, ll. 2-15.)

4. As shown in Figure 2A, the remote node (276) includes in its transport layer (90) an ARP (Address Resolution Protocol) to associate an IP address with a MAC address. (Col. 4, ll. 8-14.)

PRINCIPLES OF LAW  
ANTICIPATION

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (Internal citations omitted).

ANALYSIS  
35 U.S.C. § 102

Independent claims 1, 17, and 30 recite in relevant part a CPU in a local host that provides a MAC address to a CPD. (App. Br. 25.) Appellants argue that Bennett does not teach the recited limitation. (App. Br. 13-14.) Particularly, Appellants assert that Bennett’s ARP is located at a remote host, and that the CPU does not provide a MAC address to the NIC at the local node. (Reply Br. 15.)

The Examiner, in response, finds that Bennet’s disclosure of an ARP protocol in an Ethernet node (276) assures that at least a source MAC address is included in the Ethernet bound ARP request frame. (Ans. 10.)

Thus, the pivotal issue before us is whether one of ordinary skill in the art would find that Bennett's use of an ARP protocol in a remote node teaches that a CPU at the local node provides a MAC address to a CPD. We answer this inquiry in the negative.

As detailed in the Findings of Facts section above, Bennett discloses a local node having a NIC to examine incoming TPC/IP packets, and a CPU to process the packets. (FF. 1-3.) Bennett further discloses a remote node having an ARP protocol to associate an incoming IP address with a MAC address. (FF. 4.) One of ordinary skill in the art would readily recognize that, as correctly pointed out by Appellants, Bennett teaches, at best, the transport layer of a remote node having an ARP to translate incoming IP addresses. We find nowhere in Bennett any indication that the CPU in the local node provides a MAC address to the NIC. The Examiner's finding that Bennett's Ethernet node must have provided a MAC address to the CPD, still falls short of meeting the claimed limitation since it does not particularly indicate that such MAC address is being sent from the CPU to the CPD at the local node. It therefore follows that Appellants have shown that the Examiner erred in finding that Bennett anticipates independent claims 1, 17, and 30.

Claims 2 through 8, 10 through 14, 16, 18 through 27, 29 31 through 40, and 42 incorporate the cited limitation of independent claims 1, 17, and 30 by dependency. It follows for the above reasons that Appellants have similarly shown that the Examiner erred in finding that Bennett anticipates 2 through 8, 10 through 14, 16, 18 through 27, 29 31 through 40, and 42.

CONCLUSION OF LAW

(1) Appellants have established that the Examiner erred in rejecting claims 1 through 8, 10 through 14, 16 through 27, 29 through 40, and 42 as being anticipated under 35 U.S.C. § 102(e) by Bennett.

(2) On this record, claims 1 through 8, 10 through 14, 16 through 27, 29 through 40, and 42 have not been shown to be unpatentable.

DECISION

We reverse the Examiner's rejection of claims 1 through 8, 10 through 14, 16 through 27, 29 through 40, and 42.

REVERSED

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